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Application Serial No. 09/892,727
Attorney Docket No. 60027.0018USU1/BS01040**REMARKS**

This Amendment is in response to the Office Action dated October 19, 2006, (hereinafter the "Action"). Examination and reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1, 2, 4-10, 12-22, and 24-35 were pending in the application, of which Claims 1, 6, 20, 21, 25, and 26 are independent. Claims 1-2, 4-5, 21-22, 24, and 26-27 were rejected under 35 U.S.C. §112, first paragraph and Claims 1-2, 4-10, 12-22, and 24-35 were rejected under 35 U.S.C. §103(a). In addition, the specification was objected to under 35 U.S.C. § 132(a). Applicants hereby address the Examiner's rejections in turn.

Substance of Interview Summary

A telephonic interview occurred between the undersigned, Murrell Blackburn and Examiner Hai Tran on Friday, December 22, 2006. The interview covered an objection to the specification and the rejections to claims 1-2, 4-5, 21, 22, 24, 26, and 27 under 35 U.S.C. 112. The interview also covered the rejection to claims 1-2, 4-10, 12-22, and 24-35 under 35 U.S.C. 103(a) as being unpatentable over Middeke et al., U.S. Patent No. 6,445,907, (hereinafter "Middeke"), in view of Rangarajan, U.S. Patent No. 5,987,514 (hereinafter "Rangarajan").

The Examiner agreed to withdraw the objection the specification and the rejections under 35 U.S.C. 112 per the amendments to the claims and the remarks. The undersigned also pointed out that Middeke in view of Rangarajan did not teach or suggest each and every feature of the amended independent claims, for example, "removing the first and second diagnostic agent from the media delivery device."

The Examiner indicated that the amendments would likely overcome the art of record but would require further search to determine patentability. Specifically, the Examiner indicated that the arguments made by the undersigned have merit, however further examination and/or search is still required. This written response is thus, submitted in follow-up to the telephonic interview for consideration by the Examiner, as it is believed to have placed the application in condition for allowance. Should the Examiner send another Office Action based on new art, Applicants respectfully request another interview to determine what claim amendments would be sufficient for a notice of allowance.

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Objection to Specification - 35 U.S.C. § 132(a)

The Action objected to the specification under 35 U.S.C. 132(a), as introducing new matter. Specifically, the Action states, “[i]t should be appreciated that between steps 426 and 428 the diagnostic software may be removed to conserve valuable memory resources” constitutes new matter. Applicants respectfully traverse this objection.

As indicated in the response filed August 8, 2006, support for the amendment can be found in the original disclosure on page 5, lines 9-11. See Response Filed August 8, 2006, page 10, line 19. Specifically, the disclosure states: “[t]he tool also should permit the temporary installation of diagnostic software for troubleshooting and the subsequent removal of that software to conserve valuable memory resources.” See Original Disclosure, page 5, lines 9-11. In addition, Applicants original disclosure discloses the uploading of an intelligent diagnostic agent. See Original Disclosure, page 17, lines 10-11.

Furthermore, Applicants have amended to specification as indicated above. Applicants respectfully submit that the amendment overcomes this objection and adds no new matter. Applicants contend that the mere rephrasing of a passage does not constitute new matter. See MPEP § 2163.07; In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

Claim Rejections - 35 USC § 112

In the Action Claims 1-2, 4-5, 21, 22, 24, 26, and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Action states:

The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. See Action, page 3, lines 10-14.

Independent Claims 1, 21, and 27 have been amended, and support for the amendments can be found in the amended paragraph submitted with this current Amendment and/or remarks

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in support of the amended paragraph, *supra*. Applicants respectfully submit that the amendments overcome this rejection and add no new matter.

Claim Rejections - 35 USC § 103

Claims 1-2, 4-10, 12-22, and 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Middeke et al., U.S. Patent No. 6,445,907, (hereinafter "Middeke"), in view of Rangarajan, U.S. Patent No. 5,987,514 (hereinafter "Rangarajan"). Applicants respectfully traverse this rejection.

Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements:

- (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings;
- (ii) a reasonable expectation of success; and
- (iii) the prior art references must teach or suggest all claim limitations.

See MPEP §2143; In re Dembiczak, 175 F.3d 994 (Fed. Cir 1999); In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996).

Applicants respectfully submit that the references used in the Action fail the third prong of obviousness in that, the cited references fail to teach or suggest all claim limitations. Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, *inter alia*, "removing the first diagnostic agent from the media delivery device," and "removing the second diagnostic agent from the media delivery device." Independent Claims 6, 20, 21, 25, and 26 each includes similar recitations.

In contrast, Middeke at least does not disclose the aforementioned recitations. Per the Action's admission, Middeke discloses the diagnostic agent is "pre-loaded" on the media delivery device. (See Action, page 7, lines 1-2.) In addition, the Action states that Middeke deletes the first diagnostic agent by resetting the receiver to factory defaults. If the factory

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default has a "pre-loaded" diagnostic agent then resetting the media delivery device to factory defaults will not delete the first diagnostic agent. Consequently, Applicants respectfully submit that Middeke does not disclose removing the first and/or second diagnostic agent from the media delivery device.

Furthermore, Rangarajan does not overcome Middeke's deficiencies. Rangarajan is being used by the Action to show uploading a second diagnostic agent. Rangarajan does not disclose uploading a second diagnostic agent. Rangarajan merely discloses sending a second event request which could be followed by a third event request and so on. (See Rangarajan col. 5, line 64 - col. 6, line15.) An event request is not a diagnostic agent. An event request is a request that *directs the mid-level manager to poll a device, i.e. the mid-level manager collects information from the device.* (See Rangarajan col. 2, lines 24-27.) A diagnostic agent has to ability to autonomously, among other things, 1) perform various system diagnoses, 2) identify a problem, 3) indicating a failure to identify a problem, 4) attempt to remedy a malfunctioning device, and 5) identify the device upon which it is installed. (See Applicants' Disclosure page 11, lines 16-25 and page 14, lines 24-25.) Therefore, sending an event request of Rangarajan is *not the same* as uploading a diagnostic agent as in embodiments of Applicants' invention. Like Middeke, Rangarajan at least does not disclose uploading a second diagnostic agent to the media delivery device, in response to a determination that the first diagnostic agent is not functional. Moreover, if Rangarajan does not disclose uploading a first or second diagnostic agent, the Rangarajan cannot disclose removing the first or second diagnostic agent. Consequently, Applicants respectfully submit that Rangarajan does not disclose removing the first and second diagnostic agent from the media delivery device.

Combining Middeke with Rangarajan would not have led to the claimed invention because Middeke and Rangarajan, either individually or in any reasonable combination, at least do not disclose "removing the first diagnostic agent from the media delivery device," and "removing the second diagnostic agent from the media delivery device." as recited by independent Claim 1. Independent Claims 6, 20, 21, 25, and 26 each includes a similar recitation. MPEP §2143.03 citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) states that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim

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limitations much be taught or suggested.” In light of the above remarks, Applicants respectfully submit that the Action has failed the third prong of obviousness in that the cited references do not teach or suggest all the claim limitations. Accordingly, independent Claims 1, 6, 20, 21, 25, and 26 each patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 1, 6, 20, 21, 25, and 26.

Dependent Claims 2, 4, 5, 22, 24 and 27-35 are also allowable at least for the reasons described above regarding independent Claims 1, 6, 20, 21, 25, and 26, and by virtue of their respective dependencies upon independent Claims 1, 6, 20, 21, 25, and 26. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 1, 2, 4, 5, 21, 22, 24, and 26-35.

II. Dependent Claim 15

The Action rejected dependent Claim 15 by taking “Official Notice.” As a result, Applicants respectfully suggest that the Action has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teach or suggest every claim limitation. See MPEP § 2143. There is nothing in the prior art cited by the Examiner that discloses “wherein the communication link is an asymmetric digital subscriber line”, as recited by dependent Claim 15. Accordingly, dependent Claim 15 patentably distinguishes the present invention over the cited art, and Applicants respectfully requests withdrawal of this rejection of dependent Claim 15.

If the Examiner continues to rely on this unsupported contention, Applicants respectfully request the Examiner to provide support. See In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant);

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MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

III. New Claim 36

Claim 36 has been added by this amendment. Applicants respectfully submit that Claim 36 is allowable over the cited art and that they add no new matter. Support for new Claim 36 can be found in the specification at least on page 15, lines 1-4.

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In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Action. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,

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